



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,131	12/15/2003	Joseph A. Russo	LOT920030069US1 (023)	5725
46321 7590 05/14/2009 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487				
EXAMINER				
LIN, WEN TAI				
ART UNIT		PAPER NUMBER		
2454				
MAIL DATE		DELIVERY MODE		
05/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/737,131

Applicant(s)

RUSSO ET AL.

Examiner

Wen-Tai Lin

Art Unit

2454

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 31-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 31-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1-10 and 31-50 are presented for examination.
2. It is noted that in the previous office action filed 11/21/08 claims 2, 4 and 8 were objected to because a lack of antecedence relationship issue was raised for the term “implementing an enrollment model” between claims 2, 4 and 8, and its first occurrence in claim 1, line 5. In response, Applicant amended the term in the dependent claims to “the implementing an enrollment model”. However, it appears that the phrase can be further modified to “implementation of the enrollment model”, or “the implementation of an enrollment model” depending on whether a same enrollment model is being implemented or not.
3. Claim 30 is objected to because it is reinstated as a new claim after the old claim 30 was canceled. This appears to be caused by a typographical error. For this instant office action, claim 30 is being construed as claim 40. Correction is requested in response to this office action.
4. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

Claim Rejections – 35 USC § 101

5. Claims 1-10 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process.

Specifically, the method for managing member enrollment including steps of end users to be enrolled, implementing an enrollment model to determine the qualified users and updating the community membership is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. For example, an administrator may manually organize or enroll members for a computer learning class, or the so called collaborative computing community. It is note that in the arguments Applicant appears to rely on the definition of the collaborative computing community recited in paragraph [0003] of the specification to indicate that members of the community have access to certain resources and tools. Applicant is reminded that (1) the definition found in paragraph [0003] is not a precise and exclusive definition for the collaborative computing community in the claims because paragraph [0003] only gives a possible definition (note the phrase “can be defined” at line 6 of paragraph [0003]); and (2) even if Applicant puts the paragraph [0003] definition in the claims and disregard whether the resources and tools involves hardware machine or not, there is still a requirement that the method steps be performed on a machine. As such, it is clear that claim 1 fails the “tie to a machine” test.

In the remarks filed 2/23/09, Applicant argues that claim 1 transforms a particular article into a different state or things, wherein the act of the creation is a transformation and the services that manage the member enrollment are the article [see paragraph 2 on page 12 of the Remarks]. The examiner respectfully disagrees.

“Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances. (See page 28 of In Re Bilski 88 USPQ2d 1385).

Based on the foregoing argument, Applicant appears to agree that the method of claim 1 is an act of creating a community by providing enrollment services. This is true because before application of the enrollment process, the community of claim 1 does not exist. Thus claim 1 is a process that creates something from nothing or from something of unknown state. On the other hand, in a transformation process the article being transformed must possess well understood state before and after the transformation because otherwise a relevant process can not be subscribed.

Additionally, Applicant's interpretation of the service as an article has broadened the original meaning of an article as being a “physical objects or substances” or “representative of physical objects or substances”. This has pushed the claimed process to the extreme of being reciting a fundamental principle that would pre-empt substantially all uses of the fundamental principle if allowed. Consider a wide variety of social, academic, and business related gatherings (e.g., weddings, religious ceremonies, conferences, and learning/training classes) wherein organizers or sponsors of various gathering events all have certain criteria (i.e., enrollment model), in mind or in written form, for adopting/enrolling members into groups, assigning roles to the members, and making certain tools and/or resources accessible to its members. Allowing

patent protection to Applicant's claimed process would certainly prevent others from practicing these fundamental principles of grouping process.

For at least the foregoing reasons, it is maintained that the method of claims 1-10 features non-statutory subject matter.

6. Claims 31-40 are rejected under 35 U.S.C. 101 because the language of the claims raises questions as to: (1) whether the claimed computer readable storage medium is a paper medium that is made readable by a computer via, for example, a scanner and OCR software, or it is a conventional electronic storage medium directly accessible by a computer? and (2) whether the phrase "when executed" in the preamble refers to a program performed by a person or by a computer? Specifically, the claim language could be broadly interpreted as a program stored on a piece of paper, though the program itself is readable by a computer (e.g., via a scanner and OCR), a person could also perform the claimed method steps as set forth in the 101 rejection of claims 1-10 above. That is, for the same reasons set forth in the rejection of claims 1-10 above, claims 31-40 are rejected under 35 USC 101 as being not tied to a machine, not invoking a transformation process, and preventing others from practicing groupings of people based on the essential principles.

Claim Rejections - 35 USC § 102

7. Claims 1-9, 31-39 and 41-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Olivier [U.S. Pat. No. 6480885].

8. Olivier was cited in the previous office action.

9. As to claim 1, Olivier teaches the invention as claimed including: a method for managing member enrollment in a collaborative computing community [e.g., col.14 line 55 – col. 15 line 21; col. 17 lines 7-39], the method comprising:

identifying one or more end user persons for enrollment in the collaborative computing community [e.g., Abstract];

implementing an enrollment model to determine whether to enroll the one or more identified end user persons as members in the community; and updating community membership to enroll the one or more end user persons based on the implemented enrollment model. [e.g., col.10, lines 43-59. Note that here the residence distance and age range form an enrollment model for determining members of a neighborhood community].

10. As to claim 2, Olivier further teaches that implementing an enrollment model includes designating one or more community members as administrators with the authority to grant enrollment to the one or more end user persons [e.g., Fig. 8; col.10, lines 43-59; i.e., the user who initiate a mailing list for certain activity or topical discussion is an administrators having the authority to determine the members to be included in the specific mailing list by adjusting the parameters of the enrollment model].

11. As to claim 3, Olivier further teaches that including providing the one or more community members with the ability to remove a community member from the community [e.g., col.14, lines 40-44].

12. As to claim 4, Olivier further teaches that implementing an enrollment model to determine whether to enroll the one or more identified end user persons as members in the community includes:

identifying one or more criteria for defining a role in the collaborative computing community [e.g., 242-246, Fig.2];

obtaining role profiles for each of the end user persons [e.g., 202, Fig.2; 306, Fig. 3A];
and

determining if one or more role profiles match the one or more criteria [e.g., 234, Fig.2; Fig.4; col.5, lines 51-67].

13. As to claim 5, Olivier further teaches that the one or more criteria for defining a role in the collaborative computing community includes payment of a predetermined fee [e.g., col.20, lines 13-16].

14. As to claim 6, Olivier further teaches that implementing an enrollment model includes providing one or more of the end user persons with the ability to grant enrollment to themselves [e.g., col. 11, lines 47-57; col.23, lines 38-56; i.e., each potential candidate is given the ability to grant enrollment to themselves by specifying one-way or mutual acceptance criteria].

15. As to claim 7, Olivier teaches that the method further includes providing the one or more end user persons with the ability to remove themselves from the community [e.g., col. 14, lines 16-19].

16. As to claim 8, The Olivier further teaches that implementing an enrollment model includes designating one or more community members as a sponsor member [i.e., users who establish subscriptions to an electronic mailing list] having privileges, the sponsor member granted a further privilege of sponsoring one or more of the end user persons for community membership [e.g., screen other users] as a sponsored member [i.e., users who subscribes the mailing list], wherein the sponsored member is granted enrollment in the community with privileges equal or less than the privileges of the sponsor member [Abstract: lines 3-9; note that the sponsor member is also in the same mailing list, enjoying the same privileges as the sponsored members, in addition to the privilege of “screening other users”] .

17. As to claim 9, Olivier further teaches that the sponsored member is enrolled as a community member if voted into the community [e.g., col. 14 line 55 – col. 15, line 2; i.e., a sponsored member can be to become one of the moderators].

18. As to claims 31-39 and 41-49, since the features in these claims can also be found in claims 1-9 and/or the cited passages, they are rejected for the same reasons set forth in the rejection of claims 1-9 above.

19. Claims 10, 40 and 50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C.101, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

20. Applicant's arguments filed on 2/23/09 for claims 1-9 have been fully considered but they are not deemed to be persuasive.

21. Applicant argues in the remarks that: (1) with respect to claim 1, Applicant argues that the prior art does not teach the collaborative computing community as defined in Applicant specification, paragraph 0003 ; and (2) with respect to claim 2, Applicant argues that Olivier fails to teach the "authority to grant enrollment to the one or more end user persons".

22. Examiner respectfully disagrees with applicant's remarks:

As to point 1: Applicant is reminded that the definition found in paragraph [0003] is not a precise and exclusive definition for the collaborative computing community in the claims because paragraph [0003] only gives a possible definition (note the phrase "can be defined" at line 6 of paragraph [0003]). The arguments regarding the aspect of the collaborative computing community definition is moot because the definition is not found in the claim.

As to point 2: Applicant is reminded that a sponsor of Olivier's chorus group may use proximity distance as a criterion to rule out certain system subscribers from joining the group, for

example [see e.g., Fig. 8]. Since the distance metric is given by the sponsor (or administrator), it serves as an authority to granting membership to certain qualified subscribers.

For at least the foregoing reasons, it is submitted that the prior art of record reads on the rejected claims.

23. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from

the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

May 6, 2009

/Wen-Tai Lin/

Application/Control Number: 10/737,131

Page 12

Art Unit: 2454

Primary Examiner, Art Unit 2454